

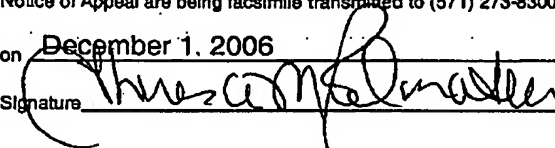
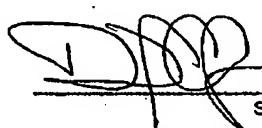
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		60,469-054; OT-4986	
CERTIFICATE OF FACSIMILE I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>December 1, 2006</u> Signature <u></u> Typed or printed name <u>Theresa M. Palmateer</u>		Application Number <u>10/010,937</u>	Filed <u>11/13/2001</u>
		First Named Inventor <u>Baranda, Pedro S.</u>	
		Art Unit <u>3682</u>	Examiner <u>Charles, Marcus</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>37,139</u> Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p> Signature <u>David J. Gaskey</u> Typed or printed name <u>248-988-8360</u> Telephone number <u>December 1, 2006</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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OT-4986**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application: Baranda, et al.
Serial No.: 10/010,937
Filed: 11/13/2001
Group Art Unit: 3682
Examiner: Charles, Marcus

For: ELEVATOR BELT ASSEMBLY WITH NOISE
AND VIBRATION REDUCING GROOVELESS
JACKET ARRANGEMENT

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is being submitted with a Notice of Appeal. As Applicant has already appealed this case and paid the associated fees, no fees are due. Applicant respectfully requests a pre-appeal brief review of the rejections under 35 U.S.C. §103.

Applicant respectfully submits that the Examiner's proposed combination of WO 01-14630 and *Kilborn, et al.* cannot be made and does not establish a *prima facie* case of obviousness against any of claims 1-4, 9, 15-16, 24, 40 and 42 for several independently dispositive reasons.

The *Kilborn, et al.* technique cannot be used to make a belt as shown in WO 01-14630 because *Kilborn, et al.* use limited length sections of a fabric layer applied to a conveyor belt. If such a sectional, limited-length approach were used for an elevator belt, that would cause even worse disruptions in the surface of the belt (e.g., seams) than the prior art elevator belt grooves that are disadvantageous as described in Applicant's background and shown in Applicant's Figure 1. The *Kilborn, et al.* technique is not useable for making elevator belt assemblies like the one in WO 01-14630.

The *Kilborn, et al.* technique is not suitable for making the belt of WO 01-14630, in which the cords are imbedded in and spaced from the surfaces of the jacket material. The *Kilborn, et al.* reference requires, for example, that the cords rest on a table and then material is applied to the cords. See, for example, column 5, lines 35-36, 45 and 51-54.

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OT-4986

Resting the cords on the table will not allow for forming a jacket that is on both sides of the cords as required in the WO 01-14630 reference. Significant, improper hindsight reconstruction of the *Kilborn, et al.* technique would be required if one were to attempt to use it for achieving the intended result of the WO 01-14630 reference.

Additionally, claim 1 requires maintaining a selected tension on each of the cords on an individual cord basis while applying the jacket such that the tension on the cords controls positions of the cords within the jacket. The *Kilborn, et al.* technique relies upon clamping the cords lying on a table to control the position of the cords relative to the material that is applied to those cords while they are stationary on the table. The *Kilborn, et al.* technique does not teach using tension as recited in claim 1 so that even if the combination could be made, the result is not the same as the claimed invention.

Regarding claim 2, the *Kilborn, et al.* reference does not teach maintaining different tensions on different cords. Instead, the *Kilborn, et al.* reference teaches the opposite. At column 1, lines 36-38 and 60, *Kilborn, et al.* state, "It is very essential that each of the tension elements should have the same tension while being built into the belt." Using the same tension on every one of the tension elements or cords according to *Kilborn's* teachings is the opposite of what is recited in claim 2 and there is no *prima facie* case of obviousness against that claim.

The proposed addition of the *Nassimbene* reference to the improper combination discussed above does not establish a *prima facie* case of obviousness against claim 2. In the *Nassimbene* reference, different lengths and higher tension occur in the middle of a V-shaped, arched belt. Neither the *Kilborn, et al.* nor the WO 01-14630 reference would allow for or benefit from such a belt configuration. Therefore, there is no motivation for adding the teachings of the *Nassimbene* reference to the proposed combination of the other two references. Further, the *Kilborn, et al.* reference expressly teaches maintaining the same tension on every cord. To addition of the *Nassimbene* reference would be directly contrary to the *Kilborn, et al.* reference and the combination cannot be made.

Claim 3 includes steps for inspecting a sample belt assembly and making an adjustment to tension on at least one cord if a sample is not consistent with a desired configuration. The *Kilborn, et al.* reference teaches an arrangement where cords are clamped at each end and lie on a table as they are covered with a material, which does not

60,469-054
OT-4986

introduce a need to take an approach consistent with Applicant's claim 3. Moreover, *Kilborn, et al.* expressly teach maintaining equal tension on all of the cords so that making an adjustment as recited in claim 3 is contrary to the teachings of the *Kilborn, et al.* reference.

The above comments regarding claims 1 and 2 are equally applicable to claims 15 and 16 and there is no *prima facie* case of obviousness against either of those claims.

Regarding claim 24, nothing in either of the WO 01-14630 or the *Kilborn, et al.* reference in any way suggests using a molding device having an opening comprising a non-linear configuration such that a thickness of a jacket exiting the opening varies across a width of the jacket as recited in claim 24.

When rejecting claims 28, 32 and 36, the Examiner contends that "it is apparent that the cords will inadvertently move while applying the jacket to the cord." Even if that were somehow true, *Kilborn, et al.* does not allow for moving the cords in a direction parallel to a length of the cords while applying the jacket material to the cords as recited in those claims. *Kilborn, et al.* expressly require that the cords are on a table and clamped at each end. Therefore, the cords are stationary in their longitudinal or lengthwise direction during *Kilborn's* process. The cords are not moveable in a direction as recited in claims 28, 32 and 36.

Regarding claims 29 and 37, the technique of adjusting the tension on at least one of the cords while applying a jacket material to the cords is directly contrary to the teachings of the *Kilborn, et al.* reference. In that reference, cords rest against a table with each end clamped in a fixed position. All tensions are equal. There is no reason to make any adjustment on the tension during a material application in *Kilborn's* process. Moreover, the *Kilborn, et al.* reference teaches that groups of cords are clamped in place on the table. It would not be possible to adjust the tension on any one of the cords without adjusting the tension on the entire group because once the clamp is released, *Kilborn's* intended tension would be eliminated. Therefore, one could not accomplish the result of claims 29 or 37 without causing significant problems during *Kilborn's* process.

Regarding claim 30, the *Kilborn, et al.* reference teaches applying a material to the cords between the clamps. That technique would not benefit from maintaining the same tension on the cords outside of the clamps because that serves no purpose. *Kilborn,*

60,469-054
OT-4986

et al. actually suggests the opposite of what the Examiner suggests because any free ends of the cords outside of the clamps are not tensioned. There is no *prima facie* case against claim 30. Claims 34 and 38 are not obvious for the same reasons.

Regarding claim 35, *Kilborn, et al.* expressly recognizes that only limited lengths of cords can be worked on at any particular time. Therefore, a continuous and uninterrupted manner of applying a jacket material as recited in claim 35 is not possible according to *Kilborn's* teachings.

When rejecting claims 40-42, the Examiner concludes that the WO 01-14630 reference inherently discloses an arrangement in which all the cords are the same. That conclusion is directly contrary to reference because it expressly shows an arrangement having some steel cords and some organic fiber cords. Therefore, claims 40-42 cannot be considered obvious.

The proposed combination of WO 01-14630, *Kilborn, et al.* and the *Harper* references cannot be made for rejecting claims 5-7. There is no motivation for adding *Harper's* water-soluble barrier material onto a polyurethane to facilitate removing a waxy or oily release agent when making the belts in the other references. *Harper* teaches avoiding a film left by a waxy or oily release agent on the surface of a molding because the polyurethane article will be subsequently painted. The belts in the WO 01-14630 and *Kilborn* references are not painted and, therefore, the teachings of the *Harper* reference have nothing to do with the teachings of the other two and there is no benefit for making the combination.

Moreover, the *Harper* reference does not teach that its polyurethane material does not contain any wax. It is not a reasonable inference to assume that a special, waxless polyurethane would be used when conventional polyurethanes typically include a wax as one of the polyurethane components. In fact, it teaches that a *waxy* mold release agent is present.

Claims 19 and 24 were rejected over the WO 01-14630 reference alone without any explanation for how that reference could possibly establish a *prima facie* case against those two claims.

The proposed addition of the *Tsai* reference for rejecting claim 8 cannot be made. The *Kilborn, et al.* and WO references require a flat belt configuration. The molding

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device in *Tsai* is intended to result in an article as shown in Figure 1 of that reference, for example. That is directly contrary to the teachings of the other two references.

Similarly, claim 14 cannot be rejected over the proposed combination of the WO 01-14630 reference and the *Harper* reference. Applicant already discussed the *Harper* reference above. There must be some motivation or suggestion to make the combination and there is nothing in either reference that provides that motivation. The belt in the WO reference is not painted and *Harper's* technique for facilitating painting has no use with that belt. Therefore, the combination cannot be made.

Regarding claims 20 and 26-27, as already discussed, there is no motivation for combining the WO 01-14630 and *Harper* references. Additionally, *Harper* does not teach a waxless polyurethane.

The rejection of claims 35 and 39 based upon the proposed combination of the WO 01-14630, *Harper* and *Pitts, et al.* references cannot be made. The *Pitts, et al.* reference could only possibly qualify as prior art, if at all, against Applicant's claims under 35 U.S.C. §102(e). The *Pitts, et al.* reference and Applicant's claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The *Pitts, et al.* reference and Applicant's application are commonly owned. Therefore, the *Pitts, et al.* reference cannot be used in an attempt to establish a *prima facie* case of obviousness under 35 U.S.C. §103.

Applicant respectfully submits that all rejections should be withdrawn.

Respectfully submitted,

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Dated: December 1, 2006

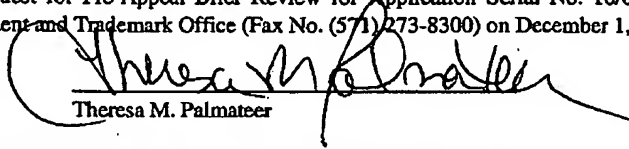
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I hereby certify that this Request for Pre-Appeal Brief Review for Application Serial No. 10/010,937 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on December 1, 2006.


Theresa M. Palmateer

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